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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/066,016 | 01/31/2002 | Bartolomew James Cunningham | 6544-1006 | 2114 |

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| EXAMINER |
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FERGUSON, MICHAEL P

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| ART UNIT | PAPER NUMBER |
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3679

DATE MAILED: 11/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,016

Applicant(s)

CUNNINGHAM ET AL.

Examiner

Michael P. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Examiner notes that the restriction requirement in the previous office action, dated September 25, 2003, has been withdrawn.

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Ireland on January 31, 2001. It is noted, however, that applicant has not filed a certified copy of the S2001/0079 application as required by 35 U.S.C. 119(b).

Specification

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.

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- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Claim Objections

2. Claims 8-10, 14, 21, 22 and 23 are objected to because of the following informalities:

Claim 8 (line 1) recites "claim 5 wherein the securing pin releasably retains the securing pin". It appears the applicants recite --claim 7 wherein the follower member releasably retains the securing pin--.

Claim 9 (line 5) recites "dipper at respective". It should recite --dipper arm at respective--.

Claim 10 (line 2) recites "securing catch". It should recite --securing catch mechanism--.

Claim 14 (line 1) recites "securing catch". It should recite --securing catch mechanism--.

Claim 21 (line 2) recites "the connecting anchorage". It should recite --a connecting anchorage--.

Claim 22 (line 2) recites "comprising. ". It should recite --comprising: --.

Claim 22 (line 6) recites "the support stay". It should recite --a support stay--.

Claim 22 (line 9) recites "the clamp arm". It should recite --a clamp arm--.

Claim 23 (line 6) recites "the support stay". It should recite --a support stay--.

Claim 23 (line 9) recites "the clamp arm". It should recite --a clamp arm--.

For the purpose of examining the application, it is assumed that appropriate correction has been made.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-9 and 15-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Heiple et al. (US 6,203,267).

As to claim 1, Heiple et al. disclose an adjustable mounting assembly for mounting a support stay **32** of a clamp arm **14** to a dipper arm **12** of a back acter, the mounting assembly comprising:

an elongated mounting member **31** defining a longitudinally extending central axis for mounting on the dipper arm with the central axis of the mounting member extending substantially parallel to the dipper arm, and

an anchor member **86** for anchoring the support stay to the mounting member, the anchor member being selectively engageable with the mounting member at two anchor locations spaced apart longitudinally along the central axis of the mounting member for respectively supporting the clamp arm in an operative orientation with the clamp arm extending outwardly from the dipper arm for co-operating with a bucket **15**

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mounted at the distal end of the dipper arm for clamping an article therebetween, and an inoperative orientation with the clamp arm and the support stay extending substantially parallel to the dipper arm (Figures 1, 2, 5 and 6).

As to claim 2, Heiple et al. disclose an assembly wherein the anchor member **86** is slideable longitudinally along the mounting member **31** between the respective anchor locations (Figure 5).

As to claim 3, Heiple et al. disclose an assembly wherein a retaining means **76,77** is provided for retaining the anchor member **86** in slideable engagement with the mounting member **31** (Figure 6).

As to claim 4, Heiple et al. disclose an assembly wherein a securing means **84** is provided for securing the anchor member **86** at the respective anchor locations (Figure 6).

As to claim 5, Heiple et al. disclose an assembly wherein the securing means comprises a securing pin **84** which is slideable through the anchor member **86** and engageable with a corresponding receiver **89** in the mounting member **31** (Figures 5 and 6).

As to claim 6, Heiple et al. disclose an assembly wherein a guide bore, through which the securing pin **84** is slideably carried, extends through the anchor member **86** and is slideable between a disengaged position disengaged from the receiver **89** and an engaged position for engaging the receiver (Figure 6).

As to claim 7, Heiple et al. disclose an assembly wherein a follower member (not shown; pin received in opening **60d**) extends transversely from the securing pin **84** and

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is co-operable with a camming surface **76** on the anchor member **86** for operating the securing pin between the engaged and the disengaged positions (Figure 6).

As to claim 8, Heiple et al. disclose an assembly wherein the follower member (not shown; pin received in opening **60d**) releasably retains the securing pin **84** in the disengaged position (Figure 6).

As to claim 9, Heiple et al. disclose an assembly wherein the anchor member **86** is selectively engageable with the mounting member **31** at a plurality of spaced apart anchor locations spaced apart longitudinally along the mounting member for supporting the clamp arm **14** at a plurality of respective operative orientations extending outwardly from the dipper arm **10** at respective different angles to the dipper arm (Figure 5).

As to claim 15, Heiple et al. disclose an assembly wherein the adjustable mounting assembly is mountable on the dipper arm **10** at a location on the dipper arm such that a connecting anchorage **34** for connecting the clamp arm **14** to the dipper arm is located between the mounting assembly and the distal end of the dipper arm (Figure 1).

As to claim 16, Heiple et al. disclose an assembly wherein when the clamp arm **14** is in the inoperative orientation the clamp arm extends from the connecting anchorage **34** towards the mounting member **31** (Figure 2).

As to claim 17, Heiple et al. disclose an assembly wherein in the inoperative position the support stay **32** extends from the mounting assembly towards the connecting anchorage **34** of the clamp arm **14** (Figure 2).

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As to claim 18, Heiple et al. disclose an assembly wherein a connecting anchorage **60** is provided on the mounting member **31** for pivotally connecting the clamp arm **14** to the dipper arm **10**, the connecting anchorage being provided longitudinally spaced apart from the anchor locations (Figure 1).

As to claim 19, Heiple et al. disclose an assembly wherein the mounting member **31** defines an elongated track extending parallel to the central axis for slideably carrying the anchor member **86** between the respective anchor locations (Figure 5).

As to claim 20, Heiple et al. disclose an assembly wherein the mounting assembly comprises one of the group consisting of a support stay **32** and a clamp arm **14** (Figure 1).

As to claim 21, Heiple et al. disclose an assembly comprising both a support stay **32** and a clamp arm **14**, the clamp arm for pivotal connection to a connecting anchorage **34** and to the support stay, and the support stay for pivotal connection to the anchor member **86** (Figure 1).

As to claim 22, Heiple et al. disclose a dipper arm **10** including a mounting assembly, the mounting assembly comprising:

an elongated mounting member **31** defining a longitudinally extending central axis for mounting on the dipper arm with the central axis of the mounting member extending substantially parallel to the dipper arm, and

an anchor member **86** for anchoring a support stay **32** to the mounting member, the anchor member being selectively engageable with the mounting member at two anchor locations spaced apart longitudinally along the central axis of the mounting

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member for respectively supporting a clamp arm **14** in an operative orientation with the clamp arm extending outwardly from the dipper arm for co-operating with a bucket **15** mounted at the distal end of the dipper arm for clamping an article therebetween, and an inoperative orientation with the clamp arm and the support stay extending substantially parallel to the dipper arm (Figures 1, 2, 5 and 6).

As to claim 23, Heiple et al. disclose a hydraulically operated machine having a dipper arm **10** including a mounting assembly, the mounting assembly comprising:

an elongated mounting member **31** defining a longitudinally extending central axis for mounting on the dipper arm with the central axis of the mounting member extending substantially parallel to the dipper arm, and

an anchor member **86** for anchoring a support stay **32** to the mounting member, the anchor member being selectively engageable with the mounting member at two anchor locations spaced apart longitudinally along the central axis of the mounting member for respectively supporting a clamp arm **14** in an operative orientation with the clamp arm extending outwardly from the dipper arm for co-operating with a bucket **15** mounted at the distal end of the dipper arm for clamping an article therebetween, and an inoperative orientation with the clamp arm and the support stay extending substantially parallel to the dipper arm (Figures 1, 2, 5 and 6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiple et al. in view of Heiple et al.₂ (US 6,209,237).

As to claim 10, Heiple et al. fail to disclose an assembly wherein the assembly comprises a securing catch mechanism for securing the clamp arm in an inoperative orientation.

Heiple et al.₂ teach an adjustable mounting assembly wherein the assembly comprises a securing catch mechanism **53** for securing a clamp arm **12** in an inoperative orientation; the securing catch mechanism ensuring that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation (Figures 1-3, column). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify an assembly as disclosed by Heiple et al. to have a securing catch mechanism as taught by Heiple et al.₂ in order to ensure that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation.

As to claim 11, Heiple et al. fail to disclose an assembly wherein a securing catch mechanism comprises at least two parts one part on the mounting assembly the other on the clamp arm or the support stay.

Heiple et al.₂ teach an adjustable mounting assembly wherein the assembly comprises a securing catch mechanism **53** comprising at least two parts one part on the mounting assembly the other on the clamp arm **12**; the two parts of the securing catch mechanism ensuring that the clamp arm is positively retained in a stored position so as

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to avoid interference with bucket operation (Figures 1-3, column). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify an assembly as disclosed by Heiple et al. to have a securing catch mechanism comprising two parts as taught by Heiple et al.₂ in order to ensure that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation.

As to claim 12, Heiple et al. fail to disclose an assembly wherein the securing catch mechanism comprises two catch mechanisms.

Heiple et al.₂ teach an adjustable mounting assembly wherein the assembly comprises a securing catch mechanism **53** comprising two catch mechanisms (latch member **54**, spring **56**); the two latch mechanisms of the securing catch mechanism ensuring that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation (Figures 1-3, column). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify an assembly as disclosed by Heiple et al. to have a securing catch mechanism comprising two latch mechanisms as taught by Heiple et al.₂ in order to ensure that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation.

As to claim 13, Heiple et al fail to disclose an assembly wherein the securing catch mechanism automatically engages when the clamp arm is in a desired inoperative position.

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Heiple et al.₂ teach an adjustable mounting assembly wherein the assembly comprises a securing catch mechanism **53** which automatically engages when the clamp arm **12** is in a desired inoperative position; the securing catch mechanism ensuring that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation (Figures 1-3, column). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify an assembly as disclosed by Heiple et al. to have a securing catch mechanism as taught by Heiple et al.₂ in order to ensure that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation.

As to claim 14, Heiple et al. fails to disclose an assembly wherein the securing catch mechanism comprises two catch mechanisms each individually restraining movement of the clamp arm from an inoperative position.

Heiple et al.₂ teach an adjustable mounting assembly wherein the assembly comprises a securing catch mechanism **53** comprising two catch mechanisms (latch member **54**, spring **56**) each individually restraining movement (restraining friction force of latch member **54**, restraining spring force of spring **56**) of the clamp arm from an inoperative position; the two latch mechanisms of the securing catch mechanism ensuring that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation (Figures 1-3, column). Accordingly, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify an assembly as disclosed by Heiple et al. to have a securing catch mechanism comprising two latch mechanisms as taught by Heiple et al.₂ in order to

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ensure that the clamp arm is positively retained in a stored position so as to avoid interference with bucket operation.

Conclusion

The prior art made of record and not relied upon is considered pertinent to the applicant's disclosure. The following patents show the state of the art with respect to mounting assemblies:

Hawkins (US 5,678,332) is cited for pertaining to assemblies having a securing catch mechanism for securing a clamp arm in an inoperative position.

Powers (US 4,770,597) and Townsend (US 5,553,408) are cited for pertaining to machines having a dipper arm, a support stay, a clamp arm and an anchor member.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Ferguson whose telephone number is (703)308-8591. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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